

Notice of Allowability

Application No.

10/767,726

Applicant(s)

OGAWA, HIDEHIKO

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to terminal disclaimer and amendment filed 27 December 2006.
2. ☒ The allowed claim(s) is/are 1,3,4,6,7,9,10,12,13,15,16,18,19,21,22,24,25,27,28,30,31,33,34,36,37,39,40,42,43 and 45.
3. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 09/461,402.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☒ Information Disclosure Statements (PTO/SB/08),
Paper No./Mail Date 12/11/06
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application
6. ☐ Interview Summary (PTO-413),
Paper No./Mail Date _____
7. ☒ Examiner's Amendment/Comment
8. ☐ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

EXAMINER'S AMENDMENT

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with William Pieprz (Registration No. 33,630) on March 14, 2007.

The application has been amended as follows:

Claim 18, line 2, "7" has been changed to -- 13 --.

2. The following is an examiner's statement of reasons for allowance: In view of Applicant's filing of a Terminal Disclaimer in compliance with 37 C.F.R. § 1.321(c), the prior rejection of claims 1-45 on the ground of nonstatutory obviousness-type double patenting as set forth in the Office action mailed September 27, 2006 has been withdrawn. In consideration of Applicant's remarks on pages 17-26 of the amendment filed December 27, 2006, it is agreed that the cited prior art, taken alone or in combination, does not disclose or suggest "a controller being configured to control the scanner to scan the image data and to convert the scanned image data into a format for e-mail transmission in response to operation of the start actuator, the controller being further configured to set the default e-mail address into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is not selected

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by the panel, the controller being further configured to set the e-mail address of the user selected by the panel into the mail message of the e-mail to which the image data is attached when the e-mail address of the user is selected by the panel, the e-mail address of the user being distinct from an e-mail address of the image data communication apparatus, whereby the e-mail address of the user set into the mail message of the e-mail can be utilized as a destination for a reply to the e-mail, the reply being sent from the receiving apparatus, the reply being returned to the e-mail address of the user, and not being returned to e-mail address of the image data communication apparatus," as now recited in base claim 1; or as similarly recited in base claims 7, 13, 19, 22, 25, 28, 31, 34, 37, 40 and 43. While similar limitations are recited in the claims of related U.S. Patents 7,119,919 and 7,184,161 (both Ogawa), neither patent recites "a memory configured to store a default e-mail address and an e-mail address of at least one user, the memory being within the image data communication apparatus" in combination with "a panel configured to select the e-mail address of at least one user stored in the memory other than the default e-mail address stored in the memory, the panel including a start actuator," as recited in the base claims of the current application.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (571) 272-

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7436. The examiner can normally be reached on Monday-Friday, 7:30-5:00, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L. Coles can be reached on (571) 272-7402. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Thomas D Lee
Primary Examiner
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tdl

March 8, 2007